

REMARKS

Claims 1-10, 16-17, and 20-41 are pending in the application. Claims 1, 2, 9, 10, 16, and 17 stand rejected under 35 U.S.C. § 102(b). Claims 3-8, 20-26, 34-35 and 27-33 stand rejected under 35 U.S.C. § 103(a). Claims 36-41 are new. Reconsideration in light of the following arguments is respectfully requested and allowance is earnestly solicited.

Claim Rejection 35 U.S.C. § 102(b)

35 U.S.C. § 102(b)

Claims 1, 2, 9, 10, 16 and 17 stand rejected under 35 U.S.C. §102(b) as being anticipated over MrAbbott (CZ1000 P Button), hereinafter *Abbott*. Applicants respectfully disagree.

With regard to the anticipation rejection under 102 U.S.C. §102(b) of Claims 1, 2, 9, 10, 16 and 17, the Office asserted that *Abbott* anticipates the present invention. Applicants disagree. “[A]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1982) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1984)) (emphasis added). The cited reference (appears) to be a “posting” from an internet web group. In particular, the message board is directed to synthesizer musicians (music.makers.synth). The **entire** citation is as follows:

>DWallace writes:

>Where is this “P” button to restore the internal patches?

Turn it over. On the bottom of the machine there is a small indentation, that almost looks like it would be for a recessed screw. On the CZ101, I seem to recall there was a “P” molded into the plastic next to it. If you take a thin probe style tool (even a straightened paper clip) and insert it into that hole, the button on the bottom will reset your memory with the original factory patches.

Abbott.

As the Federal Circuit noted, “An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of invention.” *In re*

Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (C.C.P.A. 1981) citing *Hansgirk v. Kemmer*, 102 F.2d 212, 214, 40 USPQ 665,667 (C.C.P.A. 1939)). (emphasis added.) Claim 1, recites a method of providing a known-good configuration for a computer. Claim 16 recites a machine readable medium executable to store a configuration and restore a configuration. *Abbott* fails to teach the present invention as claimed in either Claim 1 or Claim 16. *Abbott* merely teaches utilizing a paper clip to reset memory to the original factory patches of a CZ101. Moreover, *Abbott* fails to even teach what a CZ101 is (i.e., a machine, a synthesizer), as is required for a reference under 35 U.S.C. § 102, as is noted above. *Abbott* simply teaches that the button on the bottom will reset your memory to the original factory patches. This is not the present invention.

Further, *Abbott* gives no indication of what is a “factory patch”. The Office’s additional reference, Andrew S. Gianni-CZ1000 Internal Battery-March 01, 1995-re.music makers.synth, indicates that patches are merely “banks of sounds”. *Gianni*, Page 3. This is not the present invention. The present invention is a method of storing a known-good configuration for a computer and then subsequently restoring the known-good configuration. A configuration may include “hardware and software configuration parameters”. Page 4, lines 5-6. Removal of the pending rejection to Claims 1, 2, 9, 10, 16 and 17, under 35 U.S.C. §102(b) is respectfully requested, and allowance is earnestly solicited.

Claim Rejection 35 U.S.C. § 103(a)

35 U.S.C. § 103(a)

Claims 3-8, 20-26, and 34-35 stand rejected as obvious under 35 U.S.C. § 103(a) in view of *Abbott*, further in view of “readily recognized knowledge”. Applicants respectfully disagree. Neither *Abbott*, nor the proffered “readily recognized knowledge” teach the method as recited in claims 3-8, 20-26, 27-33 and 34-35.

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art

suggested the desirability of the modification. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) *quoting In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988).

As the Office is well aware, Applicant is required to seasonably challenge statements by the Office that are not supported on the record, and failure to do so will be construed as an admission by Applicant that the statement is true. M.P.E.P. §2144.03. Therefore, in accordance with Applicant's duty to seasonably challenge such unsupported statements, the Office is hereby requested to cite a reference supporting the position that it would have been obvious to utilize *Abbott* in combination with the "readily recognized knowledge" to achieve the presently claimed invention. If the Office is unable to provide such a reference, and is relying on facts based on personal knowledge, Applicant hereby requests that such facts be set forth in an affidavit from the Examiner under 37 C.F.R. 1.104(d)(2). Absent substantiation by the Examiner, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn.

The arguments forwarded with respect to the anticipation rejection of claims 1, and 16 are equally applicable to the current rejection, inasmuch as Claims 3-8, 20-26, 27-33 and 34-35 depend from either Claim 1 or Claim 16. Moreover, the Office fails to provide any motivation to combine *Abbott* with the "readily recognized knowledge" as is suggested by the Office. Removal of the rejection under 35 U.S.C. §103(a) to Claims 3-8, 20-26, 27-33 and 34-35 is respectfully requested and allowance is solicited.

CONCLUSIONS

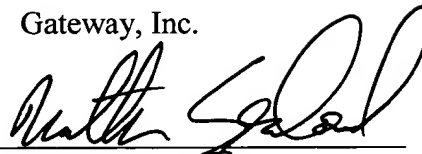
In light of the forgoing, reconsideration and allowance of the claims is earnestly solicited.

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Respectfully submitted,

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